REMARKS

Claims 3, 4, 10, 11, 17, and 18 have been amended to more clearly set forth antecedents for highlighted icons. Accordingly, it is submitted these claims are no longer indefinite, and it is respectfully requested that Examiner withdraw the objection to and consequent rejection of these claims under 35 U.S.C. 112, second paragraph.

The Abstract has also been amended as suggested by Examiner.

Applicants respectfully traverse the rejection of claims 1-30 under 35 U.S.C. 102(e) as being anticipated by the Erten Publication. In this connection, Applicants thank Examiner for the telephone interview extended to their attorney, J. B. Kraft on April 21, 2004. As Applicants explained in that interview, a rejection based on anticipation under 35 U.S.C. 102, must expressly or impliedly teach every element of invention without modification. The Examiner's application of the Erten Publication does not meet this standard. Every claim in this Application requires that when an approaching cursor is within a predetermined distance from a plurality of items or icons in a set, all of the plurality of items or icons in the set are highlighted.

While the Erten publication discloses standard highlighting of icons as a cursor approaches, there is nothing in Erten to suggest that a group of a plurality of icons are highlighted when the cursor approaches. Applicants have reviewed the Erten publication in general as well as the sections cited by Examiner, and Applicants fail to find anything in Erten suggestive of highlighting a plurality adjacent icons.

The present invention addresses the problem of interactively accessing and selecting icons and like items from display screen areas crowded with a high density of

icons or like items. The number of icons that the user has to contend with in the navigation of his cursor to his target icon has been increasing greatly. These icons may b arranged in many layers of windows. In certain portions of the users' display screen, there may be dense populations of icons. The icons may overlap or be stacked one on the other. In addition, users are extensively using laptop computers and palm-type devices, including Personal Digital Assistants (PDAs) and cell phone displays to supplement their desktops. Thus, the desktop displays need to be replicated on these smaller screen devices to thereby make the icons even more closely spaced. The selection of icons or like items from crowded screen areas presents a problem.

The key to the present invention is if it is determined that the group of icons being approached by the cursor is so closely spaced that it is not possible to directly access a selected icon without touching other icon, then all of the closely spaced icons in the set are highlighted. This permits the system to subsequently distinguish between the highlighted icons to select the most significant icon. Erten does not highlight more than a single icon.

Claims 5-7, 12-14, 19-21, 23-24, 26-27, and 29-30 have further limitations relating to the subsequent distinguishing between the highlighted icons in the group to select the most significant or target icon. There is sequential highlighting of the icons in the group for a defined period of time during which the icon may be selected. The rejection of these claims over Erten in view of Davie et al. (US 5,973,665) under 35 U.S.C. 103(a) is also respectfully traversed.

The Davie Patent is Owned by the Assignee of the Present Application, and Thus Can Not Preclude Patentability Under 35 U.S.C. 103(c).

The present Application and the Davie Patent reference were commonly owned by International Business Machines

corporation, the Assignee herein at the time the invention of the pres nt Application was made.

The file of the present Application indicates that an Assignment of the present Application to said Assignee is filed in the Patent Office. Also the printed Davie Patent indicates that it is assigned to the same Assignee.

Since the present Application has a filing date after November 29, 1999, and the Davie Patent would qualify as prior art under the provisions of 35 U.S.C. 102(e), it is submitted that the Davie patent can not be used to preclude patentability based upon 35 U.S.C. 103(c). [Examiner's attention is directed to MPEP Sections 706.02(l); (l)(1); (l)(2); and (l)(3).]

Accordingly, Examiner is respectfully requested to withdraw Davie as a reference.

In any event the Davie disclosure involves temporary highlighting of items on a display screen for a purpose which is very different from that of Erten or from that of the present invention. Davie deals with a user proceeding through a sequence of steps through the selection of a sequence of representative items on a display screen. Thus, when a user selects a given item on a display screen, the selected item is highlighted, and a next item on the display screen which the user is likely to select is also highlighted to enable the user to select such next item should he choose to do so. Davie does provide for ending the highlighting of such next item if the user does not select during a set period of time. However, there is nothing in either the basic Erten reference or in the modifying Davie reference relating to the highlighting of a group of closely spaced adjacent items as a cursor approaches in order that the user may be then be stepped through each highlighted item for selection purposes. That combination and modification in the combination of

references can only be made in the light of Applicant's own invention.

Accordingly, Applicants submit that Examiner's proposed combination and modification of the two references is being made not with the requisite foresight of one skilled in the art, but rather with the hindsight obtained solely by the teaching of the present invention. This approach cannot be used to render Applicants' invention unpatentable.

> "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art references of record convey nor suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." W. L. Gore, 721 F 2d at 1553, 220 USPQ, pp. 312-313.

> "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." In re Fine, 5 USPQ 2d 1596 (C.A.F.C.) 1988.

In view of the foregoing, it is submitted that claims 1-30 are in condition for allowance, and such allowance is respectfully requested.

Respectfully submitted,

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